REMARKS

Claims 1-8 are pending in the application; the status of the claims is as follows:

Claims 1-3, 6, and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Japan Published Application No. (A) 8-254751 to Matsushima ("Matsushima") in view of U.S. Patent No. 4,667,489 to Nishimura et al. ("Nishimura").

Claims 4 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsushima in view of Nishimura as applied to claim 1 above, and further in view of U.S. Patent No. 5,550,587 to Miyadera ("Miyadera").

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The acknowledgement, in the Office Action, of a claim for foreign priority under 35 U.S.C. § 119(a)-(d), and that the certified copy of the priority document has been received, is noted with appreciation.

The indication, in the Office Action, that the Examiner has no objections to the drawings filed on December 7, 2000, is noted with appreciation.

35 U.S.C. § 103(a) Rejections

The rejection of claims 1-3, 6, and 7 under 35 U.S.C. § 103(a), as being unpatentable over Matsushima in view of Nishimura et al, is respectfully traversed based on the following.

Neither Matsushima nor Nishimura discloses or suggests "a photometric device for measuring an amount of light reflected from the optical element," a limitation of claim 1.

The Examiner appears to equate this claim limitation with the photometric circuit of Matsushima (figure 1, item 7). However, Matsushima does not disclose or suggest a photometric device that measures an amount of light reflected from the optical element that is retractably disposed in the optical path. The interaction of the photometric circuit 7 with the microcomputer 1 is described on page 3, paragraph 3 of the partial translation of Matsushima, and the internal operation of the photometric circuit is described on page 7, paragraph 2 of the partial translation of Matsushima. Matsushima only describes the operation of the photometric circuit and does not teach or describe a photometric device for receiving photometric information. Even if one assumes that a photometric circuit necessarily employs a photometric device, Matsushima does not disclose where this device is placed and how it receives its photometric information. Figure 1 of Matsushima is a block diagram of the various elements and therefore cannot show that photometric circuit measures an amount of light reflected from a retractable optical element. Further, page 3 of the partial translation of Matsushima, in describing the photometric circuit, similarly does not disclose or suggest that the photometric circuit measures an amount of light reflected from a retractable optical element. Figures 4 and 5 of Matsushima disclose a pellicle mirror 21 that can retract during an exposure. However, neither figure illustrates any device that could measure an amount of light reflected from the pellicle mirror. While the range finding unit 24 can receive light transmitted through the pellicle mirror when the pellicle mirror is in the down position, this is clearly not light reflected from the pellicle mirror. Further, the range finding unit receives no light when the pellicle mirror is in the up position. Thus, Matsushima does not disclose or suggest a photometric device that measures an amount of light reflected from a retractable optical element, and cannot anticipate claim 1.

Nishimura discloses a photometric device 12 that measures infrared light reflected from a coating 29 on the solid state image pickup element 10. (Nishimura, figure 1, column 2, lines 49-61.) As the solid state image pickup element is fixed in position, it is not a retractable optical element as required by claim 1. Therefore, the combination of

Matsushima and Nishimura fails to disclose or suggest "a photometric device for measuring an amount of light reflected from the optical element," a limitation of claim 1.

Claim 1 also requires the camera include two modes of shooting: (1) "a first mode in which shooting is performed without emission of the illumination light," and (2) "a second mode in which shooting is performed with emission of the illumination light." In the first mode, where the illumination light is not emitted, a driver "retracts the optical element out of the optical path." However, in the second mode, where the illumination light is emitted, the system "keeps the optical element in the optical path."

Matsushima discloses a driver that retracts the optical element out of the optical path during one mode of shooting and keeps the optical element in the optical path during a second mode of shooting. (Office Action page 2; Matsushima, figure 6, pages 11, 12, paragraph 3 of the partial translation of Matsushima.) As disclosed by Matsushima, the system first determines whether or not flash photography will be used in step 31. If the flash will be used, the system advances to step 32, where the optical element is retracted out of the optical path. On the other hand, if the system will not use the flash, the system advances to step 33, where the optical element remains in the optical path.

Matsushima therefore discloses a system where the optical element is moved out of the optical path when the camera will use the flash. In contrast, claim 1 requires the opposite: that the optical element remains in the optical path when the camera uses an illumination device. Similarly, Matsushima discloses the optical element remains fixed when the camera will not use the flash, while claim 1 requires retracting the optical element when the flash is not used. Thus, although Matsushima describes two modes, one mode where the optical element is in the optical path and one mode where the optical element is moved out of the optical path, the manner in which Matsushima implements these two modes is exactly the opposite of that required by claim 1.

Nishimura is a digital camera and thus does not include a retractable optical element. Therefore, the combination of Matsushima and Nishimura does not disclose a second limitation of claim 1 and cannot render claim 1 obvious for this additional reason.

Lastly, the Examiner takes Official Notice that it is well known to replace conventional camera film with an image sensor to form a digital camera. Applicant respectfully traverses the Official Notice by noting that although both devices are used for the recording of pictures, a film-based camera cannot be converted into a digital camera by merely replacing the type of recording media employed. As noted in the "Description of the Prior Art" of the present application, conversion of various film-based camera features to a digital camera causes an assortment of difficulties unique to digital cameras. For example, the automatic light adjustment systems of silver-halide film cameras cannot be readily implemented on digital cameras because they operate by the film's dispersive reflection of light. (See application, page 3, line 18 to page 4, line 9.) The Applicant contends that it requires skill, ingenuity, and novelty to implement a film-based camera's features on a digital camera.

In summary, the combination of Matsushima and Nishimura fails to disclose a photometric device for measuring an amount of light reflected from a retractable optical element and retracting the optical element when in a non-flash mode. Further, the Examiner's proffered reason for combining Matsushima and Nishimura, by taking Official Notice, is counter to the present application due to differences in how silver-halide film and an image sensor disperse light. Thus, for at least these three reasons, the combination of Matsushima and Nishimura fails to disclose or suggest each limitation of claim 1 and cannot render claim 1 obvious.

Because claims 2, 3, and 6 depend from nonobvious claim 1, the Applicant respectfully requests that these claims be allowed for the same reasons as claim 1. The Examiner indicates claim 7 is a method claim corresponding to apparatus claim 1.

Therefore, the Applicant additionally requests that claim 7 be allowed for at least the same reasons as claim 1.

Accordingly, it is respectfully requested that the rejection of claims 1-3, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Matsushima in view of Nishimura, be reconsidered and withdrawn.

The rejection of claims 4 and 8 under 35 U.S.C. § 103(a), as being unpatentable over Matsushima in view of Nishimura as applied to claim 1 above, and further in view of Miyadera, is respectfully traversed based on the following.

As noted above, the combination of Matsushima and Nishimura fails to disclose or suggest each limitation of claim 1. Further, Miyadera similarly fails to disclose these same limitations. By being a digital camera, Miyadera does not disclose a retractable optical element and therefore cannot disclose or suggest a photometric unit that measures an amount of light reflected from a retractable optical element nor two modes in which the retractable element is retracted in one of the two modes. Thus, the combination of Matsushima, Nishimura, and Miyadera does not disclose or suggest each limitation of claim 1 and cannot render obvious the digital camera of claim 1.

Because claim 4 depends from nonobvious claim 1, Applicant respectfully requests that claim 4 be allowed for at least the same reasons as claim 1. In addition, Applicant requests that claim 8, which depends from nonobvious claim 7, be allowed for at least the same reasons.

Accordingly, it is respectfully requested that the rejection of claims 4 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Matsushima in view of Nishimura as applied to claim 1 above, and further in view of Miyadera, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Response does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

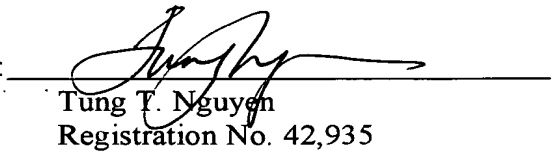
Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,

and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By: 

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